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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,501	03/10/2006	Klaus Hoffmann	0119010-00143	4212
29177 7590 02/06/2009 BELI., BOYD & LLOYD, LLP P.O. BOX 1135 CHICAGO, IL 60690				
EXAMINER				
PHUNG, LUAT				
ART UNIT		PAPER NUMBER		
2416				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/571,501

Applicant(s)

HOFFMANN ET AL.

Examiner

LUAT PHUNG

Art Unit

2416

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-17, 19, 23-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17, 19, 23, 24, 28-30 and 32 is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☒ Claim(s) 25, 27 and 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed on October 31, 2008 have been fully considered but they are not moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 25 and 31 are objected to because of the following informalities:

Claim 25, line 17, it is suggest to change "an deactivate ..." to --a deactivate...--.

The same problem exists in claim 28, line 21.

Claim 27 is object to as being dependent on an objected base claim, namely claim 25.

Claim 31, line 3, it is suggest to change "... includes a activate attribute" to --... includes an activate attribute--.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 11-14 are rejected under U.S.C. 103(a) as being unpatentable over ITU-T Q.734 (Stage 3 Description for Multiparty Supplementary Services Using SS7, 03/93, hereinafter Q.734), in view of NWB-087 ("Proposed New Recommendation Q.1912.SIP – Version.2002.06.21C", Study Group 11, Temporary Document NWB-087 of ITU-T, hereinafter "NWB").

Regarding claim 11, Q.734 discloses a method for interworking protocols to provide a performance feature in a communication network, comprising:

providing a first protocol that controls a first subscriber; (messages to/from user B per Fig. 2-1)

providing a second protocol that controls a second subscriber; (messages to/from user C per Fig. 2-1)

disconnecting an established data channel between the first subscriber and the second subscriber (user A creating private conversation with one of remote parties during three-way conversation, i.e., disconnecting established data channel between remote users B and C, per sec. 2.2.1, resulting in call A-B on hold and A-C active per Fig. 2-1)

receiving a notification of a call progress for the performance feature in accordance to the first protocol; (user B receiving notification of three-party service call per Fig. 2-1) and

interworking the notification into the second protocol. (user A communicating using messages to user B and C)

Q.734 discloses interworking but does not explicitly disclose interworking depending on a "held" status of the second subscriber or disconnecting by deactivating a transmitter for the second subscriber. However, Q.734 discloses placing the creating a private conversation (call A-C active, by placing call A-B on hold per Fig. 2-1). NWB from the same or similar fields of endeavor discloses Interworking Function IWF sending an answer depending on whether media stream has previously been set to a=inactive, i.e., in held state. (sec. 6.1.11; IWF following RFC 3261). NWB further discloses interworking between SIP and ISUP to place a call on hold by placing a media stream on hold, i.e., deactivating the transmitter (sec. 6.1.11; a=inactive being used in SIP to place a media stream on hold). Thus it would have been obvious to the person of ordinary skill in the art at the time of the invention to place the call on hold as per Q.734 by deactivating a transmitter for the second subscriber depending on held status,

i.e., if media stream had previously been set to a=inactive as suggested by NWB. The motivation for doing so would have been to avoid sending data that will not be used when the call is on hold.

Regarding **claim 12**, Q.734 further discloses

wherein the performance feature is a large conference feature in accordance to the International Telecommunications Union (ITU) standard Q.734.1 (conference calling per sec. 1) or a small conference feature in accordance to the ITU standard Q.734.2 (three party per sec. 2), and

wherein the disconnect according to the first protocol is produced by interrupting the established data channel in a central transmission mode. (disconnect by interrupting established conference call by user A as an intermediate between users B and C per Fig. 2-1)

Regarding claim 13, Q.734 further discloses wherein the deactivation occurs when a third subscriber is added to the conference or the subscriber is isolated from the conference. (user A creating private conversation, e.g., isolating user B during three-way conversation per sec. 2.2.1)

Regarding claim 14, Q.734 further discloses wherein interworking occurs when the transmitter is deactivated. (user A sending messages to both remote users when a remote user is to be placed on hold, i.e., disconnecting transmitter per Fig. 2-1).

Allowable Subject Matter

7. Claims 15-18, 19, 23-24, 28-30 and 32 are allowed.

8. Claims 25, 27 and 31 are objected to as being objected-to claims, but would be allowable if rewritten to overcome the claim objections.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form 892).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUAT PHUNG whose telephone number is (571) 270-3126. The examiner can normally be reached on M-Th 7:30 AM - 5:00 PM, F 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Q. Ngo can be reached on 571-272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/L. P./

Examiner, Art Unit 2416

/Ricky Ngo/

Supervisory Patent Examiner, Art Unit 2416